

[illegible][illegible]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Haruhiku Kouhara et al.

Serial No. 08/980,523

Filed: December 1, 1997

For: **ADAPTOR PROTEIN FRS2 AND  
RELATED PRODUCTS AND METHODS**

)  
) **Group Art Unit: 1643**

)  
) **Examiner:**

**SUBMISSION OF MISSING PARTS AND RELATED APPLICATION PAPERS**

Box MISSING PARTS  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

**1. DOCUMENTS ENCLOSED:**

In response to the **NOTICE TO FILE MISSING PARTS OF APPLICATION UNDER 37 CFR 1.53(f)**, which was mailed by the Patent Office on March 3, 1998, enclosed are:

- ☒ Combined Declaration and Power of Attorney, signed in counterpart
- ☒ Assignment of the invention to NEW YORK UNIVERSITY MEDICAL CENTER (together with PTO Form 1595)
- ☐ A Verified Statement to establish "Small Entity Status" under 37 CFR 1.9 and 1.27.
- ☒ A copy of the Notice to File Missing Parts of Application under 37 CFR 1.53(f).

**CERTIFICATE OF MAILING (37 C.F.R. §1.8a)**

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

September 2, 1998  
Date of Deposit  
SD-80959.1

  
Robert Wickman

2. **REQUEST FOR EXTENSION OF TIME:**

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply.

- ☒ Applicant(s) petitions for an extension of time under 37 CFR 1.136 [fees: 37 CFR 1.17(a)-(d)] for the total number of months checked below:

| EXTENSION<br>(months)  | FEE FOR SMALL<br>ENTITY           | FEE FOR OTHER THAN<br>SMALL ENTITY            |
|--|-----------------------------------|---|
| 1 <sup>st</sup> month  | <input type="checkbox"/> \$55.00  | <input type="checkbox"/> \$110.00             |
| 1 <sup>st</sup> & 2 <sup>nd</sup> months                                     | <input type="checkbox"/> \$200.00 | <input type="checkbox"/> \$400.00             |
| 1 <sup>st</sup> , 2 <sup>nd</sup> & 3 <sup>rd</sup> months                   | <input type="checkbox"/> \$475.00 | <input type="checkbox"/> \$950.00             |
| 1 <sup>st</sup> , 2 <sup>nd</sup> , 3 <sup>rd</sup> & 4 <sup>th</sup> months | <input type="checkbox"/> \$755.00 | <input checked="" type="checkbox"/> \$1510.00 |

3. **FILING FEES**

| BASIC FILING FEE:   |    |      |                       |            |
|---|----|------|-----------------------|------------|
| Total Claims  | 19 | - 20 | = 0 x \$22            | \$790.00   |
| Independent Claims  | 11 | - 3  | = 8 x \$82            | \$0.00     |
| Multiple Dependent Claims   |    |      | \$270 (if applicable) | \$656.00   |
| Surcharge 37 CFR 1.16(e)  |    |      | \$130 (if applicable) | \$0.00     |
| TOTAL OF ABOVE CALCULATIONS   |    |      |                       | \$130.00   |
| Reduction by 1/2 for Filing by Small Entity. Note 37 CFR 1.9, 1.27, 1.28. If applicable, Verified Statement must be attached. |    |      |                       | \$1,576.00 |
| Extension of Time (from above)  |    |      |                       | \$0.00     |
| Assignment  |    |      | \$40 (if applicable)  | \$1,510.00 |
| TOTAL FEES SUBMITTED HEREWITH   |    |      |                       | \$40.00    |
|   |    |      |                       | \$3,126.00 |

4. **METHOD OF PAYMENT OF FEES:**

- ☒ A check in the amount of \$3,126.00 is enclosed to cover the above fee(s).  
☐ Charge Deposit Account No. 12-2475 in the amount of



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 038602/0132

Jc784 U.S. PTO  
09/731660  
12/08/00

Box DAC  
Attn: Office of Petitions

In re patent application of  
Haruhiku KOUHARA et al.

Serial No. 08/980,523

Filed: December 1, 1997

For: ADAPTOR PROTEIN FSR2 AND RELATED PRODUCTS  
AND METHODS

**Amedment Accompanying Change of Inventorship under 37 CFR § 1.48(a)**

Assistant Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

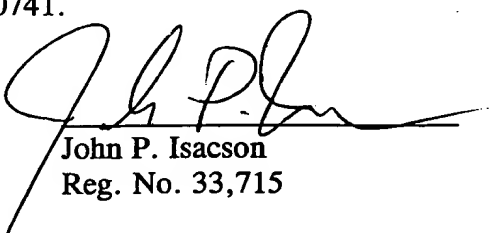
The undersigned requests that the inventorship of the captioned application be amended to delete James W. Schilling, Jr. as an inventor of the subject matter claimed therein.

Submitted herewith under separate cover is a Petition to Correct Inventorship and a Fee as set forth in 37 C.F.R. § 1.17(i).

It is believed that no additional fees are required; however, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 19-0741.

Date

Nov. 22, 2000

  
John P. Isacson  
Reg. No. 33,715

Foley & Lardner  
3000 K Street, N.W.  
Suite 500  
Washington D.C. 20007-5109  
Telephone: (202) 672-5300  
Facsimile: (202) 672-5399

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account N 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.

008021 09510260

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 038602/0132

Box DAC  
Attn: Office of Petitions

In re patent application of  
Haruhiku KOUHARA et al.

Serial No. 08/980,523

Filed: December 1, 1997

For: ADAPTOR PROTEIN FSR2 AND RELATED PRODUCTS  
AND METHODS

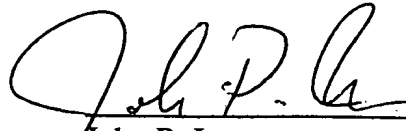
Petition to Correct Inventorship Under 37 C.F.R. § 1.48(b)

Assistant Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

James W. Schilling, Jr. was erroneously named as an inventor in the captioned application. James W. Schilling, Jr. is not an inventor of the subject matter claimed therein. Accordingly, the undersigned respectfully requests that James W. Schilling, Jr. be deleted from the inventorship of the captioned application.

Nov. 22, 2000  
Date

  
John P. Isacson  
Reg. No. 33,715

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3000 K Street, N.W.  
Suite 500  
Washington D.C. 20007-5109  
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| 姓名  | 性别 | 年龄 | 籍贯  | 职业 | 文化程度 | 政治面貌 | 健康状况 | 婚姻状况 | 子女情况 | 其他 |
|-----|----|----|-----|----|------|------|------|------|------|----|
| 王德胜 | 男  | 45 | 山东  | 工人 | 小学   | 党员   | 良好   | 已婚   | 2子1女 |    |
| 李秀英 | 女  | 38 | 河北  | 农民 | 初中   | 团员   | 良好   | 已婚   | 1子1女 |    |
| 张国强 | 男  | 52 | 河南  | 干部 | 高中   | 党员   | 良好   | 已婚   | 2子1女 |    |
| 刘小红 | 女  | 28 | 江苏  | 教师 | 大学   | 党员   | 良好   | 已婚   | 1子1女 |    |
| 陈为民 | 男  | 40 | 浙江  | 商人 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 赵大刚 | 男  | 35 | 湖北  | 工人 | 初中   | 团员   | 良好   | 已婚   | 1子1女 |    |
| 孙丽娟 | 女  | 32 | 湖南  | 农民 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 周建民 | 男  | 48 | 四川  | 干部 | 高中   | 党员   | 良好   | 已婚   | 2子1女 |    |
| 吴小芳 | 女  | 25 | 广东  | 教师 | 大学   | 党员   | 良好   | 已婚   | 1子1女 |    |
| 郑为民 | 男  | 50 | 安徽  | 商人 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 冯大刚 | 男  | 38 | 江西  | 工人 | 初中   | 团员   | 良好   | 已婚   | 1子1女 |    |
| 李秀英 | 女  | 30 | 福建  | 农民 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 周建民 | 男  | 42 | 广西  | 干部 | 高中   | 党员   | 良好   | 已婚   | 2子1女 |    |
| 吴小芳 | 女  | 28 | 海南  | 教师 | 大学   | 党员   | 良好   | 已婚   | 1子1女 |    |
| 郑为民 | 男  | 45 | 重庆  | 商人 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 冯大刚 | 男  | 35 | 贵州  | 工人 | 初中   | 团员   | 良好   | 已婚   | 1子1女 |    |
| 李秀英 | 女  | 32 | 云南  | 农民 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 周建民 | 男  | 48 | 陕西  | 干部 | 高中   | 党员   | 良好   | 已婚   | 2子1女 |    |
| 吴小芳 | 女  | 25 | 甘肃  | 教师 | 大学   | 党员   | 良好   | 已婚   | 1子1女 |    |
| 郑为民 | 男  | 50 | 宁夏  | 商人 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 冯大刚 | 男  | 38 | 青海  | 工人 | 初中   | 团员   | 良好   | 已婚   | 1子1女 |    |
| 李秀英 | 女  | 30 | 新疆  | 农民 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 周建民 | 男  | 42 | 内蒙古 | 干部 | 高中   | 党员   | 良好   | 已婚   | 2子1女 |    |
| 吴小芳 | 女  | 28 | 吉林  | 教师 | 大学   | 党员   | 良好   | 已婚   | 1子1女 |    |
| 郑为民 | 男  | 45 | 辽宁  | 商人 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 冯大刚 | 男  | 35 | 黑龙江 | 工人 | 初中   | 团员   | 良好   | 已婚   | 1子1女 |    |
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| 郑为民 | 男  | 50 | 河南  | 商人 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 冯大刚 | 男  | 38 | 湖北  | 工人 | 初中   | 团员   | 良好   | 已婚   | 1子1女 |    |
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| 郑为民 | 男  | 45 | 浙江  | 商人 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
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| 冯大刚 | 男  | 38 | 贵州  | 工人 | 初中   | 团员   | 良好   | 已婚   | 1子1女 |    |
| 李秀英 | 女  | 30 | 云南  | 农民 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
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| 郑为民 | 男  | 45 | 宁夏  | 商人 | 小学   | 无党派  | 良好   | 已婚   | 2子1女 |    |
| 冯大刚 | 男  | 35 |     |    |      |      |      |      |      |    |



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Attorney Docket No. 038602/0132**

**Box DAC**  
**Attn: Office of Petitions**

In re patent application of  
**Haruhiku KOUHARA et al.**

Serial No. 08/980,523

Filed: December 1, 1997

For: **ADAPTOR PROTEIN FSR2 AND RELATED PRODUCTS  
AND METHODS**

**Combined Petition to Withdraw Holding of Abandonment  
Under 37 C.F.R. § 1.181(a)  
and  
Petition to Revive Unintentionally Abandoned Application  
Under 37 C.F.R. § 1.137(b)**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

The undersigned hereby petitions the Commissioner to withdraw a holding of abandonment in the captioned application since the application was not in fact abandoned.

**Facts**

The captioned application was filed in the PTO with a specification, claims, abstract, and drawings on December 1, 1997 by virtue of the postcard acknowledging receipt of the same attached as APPENDIX A. The Application named Haruhiko Kouhara, Taly Spivak-Kroizman, James W. Schilling, Jr., Irit Lax, and Joseph Schlessinger as inventors.

The PTO issued a Notice to File Missing Parts (the Notice) dated March 3, 1998, attached as APPENDIX B, requiring Applicants to file, a filing fee and an Oath, and gave Applicants two months to respond, which period could be extended under 37 C.F.R. § 1.136, up to the final deadline of October 3, 1998.

Applicants timely filed a Response to the Notice (Response) on September 2, 1998 including a Combined Declaration and Power of Attorney correctly naming Haruhiko Kouhara, Taly Spivak-Kroizman, Irit Lax and Joseph Schlessinger as inventors.<sup>1</sup> The Response included Declarations from all of the named inventors except Irit Lax. A copy of the filed Response is attached as APPENDIX C.

Although the Declaration of Irit Lax was missing, the captioned application was nonetheless accepted, granted a Serial Number, and passed to the Examiner for examination on the merits. Applicants received a filing receipt before the case was passed to the Examiner, attached as APPENDIX D. In fact, a Notice of Allowance and Issue Fee Due was subsequently issued August 29, 2000, and is attached as APPENDIX E. The issue fee will be timely paid.

Applicants never received a Notice of Abandonment from the PTO indicating abandonment of the application for failure to submit a Declaration for Irit Lax in response to the Notice. However, Applicants were notified telephonically on October 19, 2000 in an interview with Examiner Hiram Bernstein that the case was abandoned for failure to submit the missing Declaration in response to the Notice.

#### **Points to be Reviewed**

37 C.F.R. 1.53(f) provides that, where a filing date has been assigned to an application filed under 37 C.F.R. § 1.53(b) or 37 C.F.R. § 1.53(d), the Applicant will be notified and be given a period of time in which to file the missing fee, oath or declaration, and to pay the surcharge due in order to prevent abandonment of the application. The time period usually set is 2 months from the date of notification by the Patent and Trademark Office. This time period may be extended under 37

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<sup>1</sup> James W. Schilling, Jr. is not an inventor as he provided technical assistance to the listed inventors. Irit Lax is an inventor of the allowed claims 09/980,523. See concurrently filed Change of Inventorship under 37 C.F.R. § 1.48(b).

C.F.R. § 1.136(a). The Oath or Declaration filed in reply to such a Notice under 37 C.F.R. § 1.53(f) must be executed by the inventors. See M.P.E.P. § 601.01(a).

Here, the Office may attempt to improperly assert that the captioned application was constructively abandoned for failure to submit the Declaration of Irit Lax in response to the Notice. However, Applicants properly replied to the Notice, as demonstrated their Response attached as APPENDIX C. Moreover, 37 C.F.R. § 1.53(h) indicates that a patent application will not be forwarded for examination on the merits until all required parts have been received. Here, the PTO expressly forwarded the application to the Examiner for examination on the merits after Applicants filed the Response including the Declarations of the inventors, and therefore, manifestly indicated that the filed Declarations satisfied requirements for responding to the Notice. Accordingly, the captioned application should not be held to be constructively abandoned since Applicants completely responded to the Notice.

Submitted herewith as APPENDIX F is the Declaration of Irit Lax as merely a Declaration supplemental to those previously filed. Such Oaths and Declarations may be filed as a matter of right after allowance; and when received they will be placed in the file by the Office of Patent Publication. See M.P.E.P. § 603.01. Applicants submit that the Declaration should not be filed or considered as amendments under 37 C.F.R. § 1.312, since it makes no change in the wording of the papers on file. See M.P.E.P. § 603.01.

#### Request

Based on the foregoing, the undersigned hereby requests the Commissioner to withdraw a holding of abandonment in the captioned application for failure to respond to the Notice.

If however the Commissioner finds that the application was constructively abandoned, the undersigned hereby petitions the Commissioner under 37 C.F.R. § 1.137(b) to revive U.S. Application Serial No. 08/980,523 which was unintentionally abandoned for failure to timely respond to the Notice. The requirements of 37 C.F.R. § 1.137(b) are satisfied as follows:

(1) A Declaration by inventor Irit Lax attached as APPENDIX F;

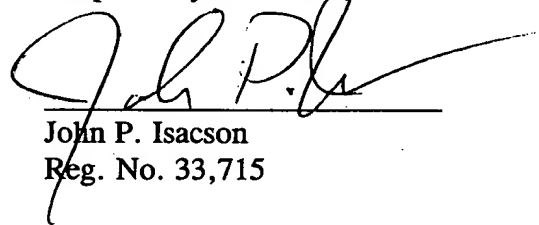
(2) The Commissioner is hereby authorized to charge a petition fee of \$1,240.00 set forth in 37 C.F.R. § 1.17(m) to Deposit Account No. 19-0741; and

(3) The entire delay in filing the required reply from the due date for the reply until the filing of the instant petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Accordingly, Applicants believe that the captioned application is not abandoned. However, if necessary, the requirements of 37 C.F.R. § 1.137(b) are met, and respectfully urge the Commissioner to revive their application. If there are any questions regarding this submission, the Patent Office is invited to contact the undersigned at the telephone number set forth below.

November 22, 2000  
Date

Respectfully submitted,

  
John P. Isacson  
Reg. No. 33,715

FOLEY & LARDNER  
3000 K Street, N.W.  
Suite 500  
Washington, D.C. 20007-5109  
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Fax: (202) 672-5399

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.

# AUTHENTICATION OF SIGNATURE

I the undersigned, Adv. Uri SRgal  
 Notary at Rishon-Lezion Israel  
 hereby certify that on 26/07/98  
 there appeared before me at my office:

~~Mr. (Mrs. Miss)~~ Tali Spivak-Kroizman  
 who is known to me personally (~~whose~~  
~~identity was proved to me by identity~~  
 signed of his (her) (their) own free  
 will the above document (the attached  
 the document marked A') (the  
 document overleaf).

In witness whereof I hereby authenticate  
 the signature(s) of Mr. (Mrs., Miss)  
Tali Spivak- Kroizman  
 by my own signature and seal this 26/07/98

NIS.131.-NIS fees charged including v.a.t.



Signature

Notary's Seal

Person appeared,  
 separately,  
 which his  
 cable.

294/88888888-8

## אימות חתימה

אני הח"מ עו"ד אורי סרגל  
 נוסריון ב' רח' רוטשילד 43 ראשל"צ  
 מאשר כי ביום 26/07/98 ניצב לפני במשרדי:

מר (ת) טלי ספיבק-קרויזמן  
 הידוע לי ידיעה אישית, שהגבתו הוכחה לו  
 על-פי העדות וההוכחה (ה) / (ה) / (ה) / (ה)  
 וחתם מרצונו והורשתי על המסמך שלעיל  
 (המפורק והמסומן באות/במספר 'א'  
 (שמעבר לדף).

ולראיה הנני מאמת את חתימתו של מר (ת) / (ה"ה)  
 טלי ספיבק-קרויזמן  
 בחתימת ידי ובחותמי, היום 26/07/98

שכר בנק 131.- ש"ח נדרש כולל מע"מ

חתימה  
 חתום הנוסריון

\* ניצבו יותר מאדם אחד, יש לפרש בשמו של  
 כל אחד לחוד בציון דרך והוכחת הזהרת  
 שנקטו לגביה.  
 הערה: מחק את הסגור מחיקה